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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,139	08/03/2001	Blair Winner	BAL6019P0331US	7439

7590

06/28/2002

Lisa V. Mueller  
GARDNER CARTON & DOUGLAS  
Suite 3300  
321 N. Clark Street  
Chicago, IL 60610

EXAMINER

PARA, ANNETTE H

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 06/28/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/922,139

Applicant(s)

WINNER, BLAIR

Examiner

Annette H. Para

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### **Drawing**

Color photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 CFR 1.84(a)(2) or (b)(2) is granted permitting their use as formal drawings. In the event applicant wishes to use the drawings currently on file as formal drawings, a petition must be filed for acceptance of the photographs or color drawings as formal drawings. Any such petition must be accompanied by the appropriate fee as set forth in 37 CFR 1.17(i), three sets of drawings or photographs, as appropriate.

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied.

Applicant is advised that should claim 2 be found allowable, claim 6 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### **Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph**

#### **Enablement**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specification does not adequately teach how to make 50011, because the plant is a hybrid and there is no indication that the parent lines are publicly available.

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The invention employs novel plants, seeds and plant parts. Since the plants and seeds are essential to the claimed invention they must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If they are not so obtainable or available, the requirements of 35 U.S.C. § 112, regarding "how to make" the invention may be satisfied by deposit. For the plant, a deposit of 2500 seeds is considered adequate to ensure availability of each claimed embodiment, but because one of the parents is a hybrid the invention is not reproducible by using the seed. The deposit of a plant is necessary to satisfy "how to make" the invention. The specification does not disclose a repeatable process to obtain the plants, seeds or plant parts, for the reasons discussed above. If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the specific plant line has been deposited under the Budapest Treaty and that it will be irrevocably and without restriction released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein. Although on page 8 of the specification the applicant discloses the deposit Accession Number as well as the place and address where the deposit was made, applicant does not show an affidavit or declaration by applicants, or a statement by an attorney of record stating that the deposit will be irrevocably and without restriction released to the public upon the issuance

- (d) a test of the viability of the biological material at the time of deposit (see 37 CFR 1.807); and,
- (e) the deposit will be replaced if it should ever become inviable.

With regard to claim 9, applicant claim an inbred marigold, but it is impossible to produce an inbred line by making a cross with a hybrid parent.

#### Written Description

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Claims 2, 6, 7, 9-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 2 and 6 are drawn to the seed of the 50011. Claim 7 is drawn to a F<sub>2</sub> generation of a *Tagetes erecta* plant.

Claim 10 is drawn to a *Tagetes erecta* plant having a lineage, which includes *Tagetes erecta* plant 50011. Claim 11 is drawn to any viable marigold seeds and plants and succeeding generations grown from the deposited seeds. However, the specification only discloses the deposited seeds obtained from the marigold plant 50011.

In analyzing whether the written description requirement is met for genus claims, it is first determined whether a representative number of species have been described by their complete structure. (It is not realistic to expect that the "complete structure" of a plant, or even a cell, could be described. Therefore the inquiry required by this portion of the written description guidelines is interpreted to be whether the phenotype of the claimed plant has been described.) In this case, the few disclosed embodiments are not representative of the enormous number of products claimed. The claims encompass every marigold seeds or plants grown from the deposited seeds. Plants have many phenotype traits, which vary independently, so millions of possible phenotypes are possible and claimed. The specification discloses only the marigold plant 50011 and the deposited F<sub>1</sub> seeds but not the heterozygous population claimed. Next, then, it is determined whether a representative number of species have been sufficiently described by other relevant identifying characteristics. It is not possible to adequately describe the claimed products because the cross of hybrid plant yields a heterozygous population. One skilled in the art would not been able to predict all of the resulting phenotypes. The limited disclosure in the specification is not deemed sufficient to reasonably convey to one skilled in the art that Applicants were in possession of the huge genera recited in the claims at the time the application was filed. Thus it is concluded that the written description requirement is not satisfied for the claimed genera.

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This rejection could be overcome by limiting the claims to the deposited seeds, plants grown therefrom and their asexually propagated progeny.

**Claim Rejections - 35 USC § 112 2<sup>nd</sup> paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9 and 10, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically:

Claim 10 the recitation "high flower-weight yield" is not defined. Since it is not known what size or quantity of flowers would constitute a "high flower-weight yield", this terminology fails to clearly set the metes and bounds of the claimed invention.

Claim 9 is confusing. It is not possible to grow an inbred plant from a hybrid seed.

**Claim Rejections - 35 USC § 102/103**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2, 6, 7, 9, 10, 11 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Russ et al. (Clemson extension). Russ et al. disclose Marigolds (*Tagetes erecta*) which are tall, having large double flowers which may measured up to 5 inches across, (Page 1, column 2, page 2, column 1). The claim does not specify that the claimed plant possesses any other phenotype, which would distinguish it from those of Russ et al. Thus, the claimed invention as a whole was at least *prima facie* obvious over, if not anticipated by, the prior art.

By stating that the claimed plant has 50011 in its lineage, Applicants are essentially reciting a process for production of the claimed plant. The courts have approved the use of 102/103 rejections for product-by-process claims. See MPEP 2113.

#### **Conclusion**

No claims are allowed.

#### **Future Correspondence**

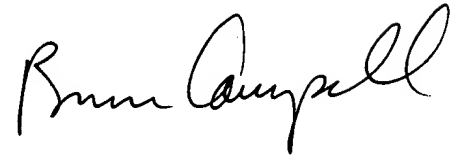
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H. Para whose telephone number is (703) 308-6327. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

A.H.P



BRUCE R. CAMPPELL, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600